

### **REMARKS**

Claims 1-49 were pending in the instant application. Claims 1-21, 26-29 and 31-49 have been canceled as being drawn to non-elected subject matter. Claim 30 has been amended to incorporate the subject matter of withdrawn claim 26. Accordingly, claims 22-25 and 30 will remain pending upon entry of the instant amendment. No new matter has been added.

Moreover, amendment and/or cancellation of the claims during pendency of the application are not to be construed as acquiescence to any of the objections/rejections set forth in any Office Action, and were done solely to expedite prosecution of the application. Applicants submit that claims were not added or amended during the prosecution of the instant application for reasons related to patentability. Applicants reserve the right to pursue the claims as originally filed, subsequently amended or added, or similar claims, in this or one or more subsequent patent applications.

### **Claim Rejections - 35 USC § 102**

Claims 22-25 and 30 stand rejected under 35 USC §102(b) over Dekker et al. (*Organometallics*, 3(9), pp. 1403-1407, 1984). In particular, the Office Action suggests that Dekker et al. discloses the ethyl ester of bromoacetic acid in dimeric form. The Office Action specifically points out the abstract on page 1403, Table II in the second column of 1404, and the "Discussion" on page 1406 in column 1 and column 2, as well as equilibria (2) on line 3. Applicants respectfully disagree, and traverse this rejection.

Applicants assert that the disclosure of Dekker et al. is not sufficient to constitute an anticipating disclosure of the ethyl bromozincacetate *crystals* of the instantly claimed invention. In fact, the general language of the abstract merely states that the "nature of the Reformatsky reagents derived from the ethyl and *tert*-butyl esters of bromoacetic acid has been studied by association measurements and NMR spectroscopy in various

solvents." The abstract continues by indicating that "[i]t appears that the reagents are dimeric in all but the most polar solvents." However, Applicants contend that the data of Table II, which shows the molecular weight and association measurements of the bromozincacetate esters, were obtained using tests "carried out in a series of **solvents**...[Emphasis added]" as described in the paragraph that bridges page 1404 and 1405. Moreover, on page 1406, in column 1 of the discussion section (first paragraph), the disclosure explicitly refers to the **tert-butyl** ester crystal structure, while the second paragraph of column 1 in the discussion section and the complete column 2 are clearly referring to the character of the esters in **solution/solvent** and the equilibria equations relating thereto. Again, Applicants reiterate, these passages that relate to ethyl bromozincacetate only in the general sense, or in solution, are not sufficient to anticipate the claims to crystals of the present invention.

Applicants respectfully emphasize that the pending claims of the instant application are drawn to crystals of ethyl bromozincacetate. As such, even assuming arguendo that Dekker et al disclose an ethyl bromozincacetate *material* in dimeric form, there is absolutely no disclosure of crystals of ethyl bromozincacetate. Furthermore, there is clearly no disclosure of the ethyl ester to which tetrahydrofuran (THF) is coordinated as recited in the claim language of claim 22 and claim 30. Accordingly, it would be clear to one of ordinary skill in the art that Dekker et al., even in light of the particular passages noted by the Office Action, does not teach or suggest crystals of ethyl bromozincacetate.

The only crystals discussed by Dekker et al. are derived from the *tert*-butyl esters, which are not within the scope of the claimed invention. In fact, the disclosure by Dekker et al. of similar conditions that were used to attempt to obtain the ethyl ester crystals without success would actually teach one of ordinary skill in the art away from the instantly claimed invention.

In further support thereof, Applicants respectfully direct the Examiner's attention to page 1404 of Dekker et al. (left column, the 18th line from the bottom), which clearly confirms that the ethyl bromozincacetate was not obtained as a crystal but rather as an amorphous material:

After the addition was completed, the reaction mixture was heated for another hour and centrifuged, and the reagent was isolated from the supernatant solution. For the ethyl reagent this was done by evaporation of the solvent (yield 75%).

In stark contrast thereto, Dekker et al. indicate on page 1404, left column, the 13th line from the bottom that:

[t]he *tert*-butyl reagent was isolated by concentrating the supernatant liquid, after which the reagent crystallized.

Moreover, Dekker et al. disclose data of an X-ray crystal structural analysis only for a *tert*-butyl reagent, and **not for an ethyl reagent**. And in fact, the authors noted that their motive for determining the crystal structure of this *tert*-butyl reagent was prompted by prior reports of this same structure by Orsini (page 1405, right column in the text, the 6th line from the bottom):

The report of Orsini et al. on the crystallinity of the reagent derived from the *tert*-butyl ester of bromoacetic acid prompted us to determine the crystal structure of this reagent.

As such, it is clear that ethyl reagent did not crystallize, and that Dekker et al. was not able to obtain crystals of ethyl bromozincacetate according to the present invention. Moreover, it is also clear that the authors did not have, and the disclosure of Dekker et al does not provide any motivation to examine or investigate the ethyl reagent with respect to potential crystal structure.

In that Dekker et al. did not obtain crystals of ethyl bromozincacetate (***much less crystals of ethyl bromozincacetate to which THF coordinates***) according to the present invention, the cited reference fails to teach or suggest each and every element of the claimed invention in any manner sufficient to sustain the rejection. Therefore, Applicants respectfully request withdrawal and reconsideration of the rejection of claims 22-25 and 30 under 35 USC §102(b) over Dekker et al.

### **CONCLUSION**

In view of the foregoing, reconsideration and withdrawal of all rejections, and allowance of the instantly claimed invention are earnestly solicited. If a telephone conversation with Applicants' attorney would help expedite the prosecution of the above-identified application, the Examiner is urged to call Applicants' attorney at the telephone number below.

### **FEE AUTHORIZATION**

Applicants believe that there are no additional fees due with this response. However, if a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 04-1105 for any fee(s) due with this response.

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Respectfully submitted,

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